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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/621,631 03/26/96 BROWN

P 621,631

EXAMINER

PM82/0710

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BILLERICA MA 01821

ART UNIT MILLER, PAPER NUMBER

28

DATE MAILED 2641

07/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/621,631

Applicant(s)

BROWN ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 3-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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1. The reply filed on July 9, 2000 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s). See paragraphs 2-3 below. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

2. Applicants' response is not understood. In paper No. 19, applicants were advised regarding filing a possible divisional CPA should they wish to change their election. However, applicants, in the filing papers for this application, stated that they were filing a continuation CPA, as noted by the Examiner in Paper No. 25. However, in the instant response, and in claim 22, ostensibly to the elected species, there is no mention of organic extraction. Further, applicants state that claims 3-21 are generic. However, many of such claims contain limitations to an organic extraction stage. Further, the previous election, Paper No. 12, filed March 17, 1998, pages 4-5 therein, included an organic extraction step. Thus, applicants' instant election cannot be understood.

3. No action on the merits having been taken in the instant CPA action, the examiner will permit a change of applicants' election should they so desire. However, if so, then this would properly be a divisional CPA, not a continuation CPA. Applicants are again required to state the materials and steps that they desire for their single ultimate elected species, and to state the claims readable thereon. This requirement is made final. The additional detail in the materials is appreciated, and it is deemed helpful to the examiner and applicants, ultimately. Applicants best interests would seem to be served by electing a single species that is detailed to such extent that it would likely be found allowable. However, regardless of applicants' elected species, upon examination, simple or detailed, applicant will not be allowed to change such species. Further, an

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ultimate species is that, a species, not a genus or subgenus. Thus, any claims more detailed than the elected species will be deemed drawn to a different species and withdrawn from consideration, until and unless they become dependent on an allowable claim. In this, applicants are reminded of the distinction between claims and species, MPEP 806.04(e) "Claims Restricted to Species."

Claims are definitions of inventions. Claims are never species. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a generic or genus claim). Species are always the specifically different embodiments.... The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the [species]....

In other words, claims are a legal artifice, which are sought for the purpose of patent protection.

Species, on the other hand, are a specific real thing, the method steps, ingredients, reactants, and products, something from reality. The election of species requirement is made final.

4. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached daily, except alternate Fridays, from about 9 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Jordan can be reached at (703) 306-4159. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
July 9, 2000



EDWARD A. MILLER  
PRIMARY EXAMINER